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REMARKS

Claims 1-19 are pending in this application. Claims 8 and 14 are amended for minor grammatical corrections that do not affect the scope of the claims. Reconsideration in view of the following remarks is respectfully requested.

The Office Action rejects claims 1, 14, and 15 under 35 U.S.C. §112, first paragraph. The Office Action alleges the term "a third device" was not properly described in the specification and is new matter. Applicants disagree. In particular, exemplary support for the third device exists at least at page 6, lines 16-19 as a "terminal of a vendor" and at page 7, lines 20-23 as "compatible data equipment of the vendor." Thus, the subject matter was described in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

The Office Action rejects, under 35 U.S.C. § 103, claims 1-17, over Storck et al. (U.S. Patent No. 5,434,395), Kawan et al. (U.S. Patent No. 6,289,324), and Kramer et al. (U.S. Patent No. 6,324,525) and claims 18 and 19 over Storck et al. and Kawan et al. These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

Applicants assert that none of the cited references disclose or suggest granting access to a third device to said personal data therein only when a second data storage device is operatively coupled to a first data storage device, as recited in independent claim 1 and similarly recited in independent claim 14.

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Storck et al. uses an interfacing circuit that controls data transfer between one data carrier and another data carrier when the data carriers are identified as compatible (Abstract). Storck does not disclose a three party transaction between multiple devices and such is even admitted by the Office Action. The Office Action then alleges Kramer discloses a three party transaction, a first interface circuit coupled to a memory device granting conditional access to a third device to data therein using an appropriate data exchange protocol between a first personal data storage device and a third device.

Unfortunately, neither Storck nor Kramer disclose or suggest granting access to a third device to said personal data therein only when a second data storage device is operatively coupled to a first data storage device. Such a feature is not disclosed in either reference. In fact, such a feature is not even alleged by the Office Action. Thus, the Office Action has failed to make a *prima facie* case of obviousness.

Furthermore, the Office Action alleges it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Storck... to employ Kramer in order to enable optimum and secure two party and three party electronic transactions. Applicants disagree. The Office Action has not provided proper motivation to combine the references. In particular, Kramer does not provide motivation to combine its disclosed settlement of aggregated electronic transactions over a network with Storck's disclosed method and device for effecting a transaction between a first and at least one second data carrier. There is no disclosure in the references of how the teachings of Kramer's electronic transactions would be useful in combination with the teachings of Storck's data transfer between cards.

As evidence of the lack of motivation, Applicants assert that the teachings of Kramer are not combinable with the teachings of Storck because they relate to different procedures. In particular, the "transaction" disclosed by Kramer is not the "transaction" disclosed by Storck. Kramer deals with transactions that relate to secure, electronic payment in change for goods and services purchases over a communication network (col. 1, lines 26-29). For example, Kramer discloses such transactions are those that can dispense some form of economic value, such as on-line payments and cashless payment transactions (col. 2, lines 23-28).

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Storck deals with a different kind of "transaction." In particular, Storck expressly discloses that "transactions" are the transferring of data from one card to another (col. 11, lines 34-38 and 52-56 and col. 1, lines 9-20). Copying data from one card to another is not a payment transaction. In particular, Storck involves copying data from a "master" card to a "virgin" card (col. 11, lines 34-60). This is a different kind of transaction from the electronic payments disclosed in Kramer. Thus, the teachings of Kramer are not combinable with the teachings of Storck because they relate to different procedures.

Applicants also assert that none of the cited references disclose or suggest user data in either a first or second personal data storage device is accessible and usable only when the first and second personal data storage devices are in communication with each other, as recited in independent claim 8.

The Office Action alleges Storck discloses data in either of first or second personal data storage device is accessible and usable only when first and second personal data storage devices are in communication with each other at col. 12, lines 45-48. Applicants disagree. In particular, the cited section states, "It is also possible to divide up an authorization level between two or several slave cards which will then need to be used in a complimentary manner or simultaneously." Applicants assert this does not disclose data in either of first or second personal data storage device is accessible and usable only when first and second personal data storage devices are in communication with each other. In particular, the statement of using two cards simultaneously does not disclose that the cards are in communication with each other. For example, the cards can be used simultaneously by using each card in communication with a separate device (which is not disclosed) without the cards being in communication with each other. In fact, there is no disclosure that this results in the cards being in communication with each other. Thus, the cited section does not disclose data in either of first or second personal data storage device is accessible and usable only when first and second personal data storage devices are in communication with each other.

In fact, the cited section does not disclose data is accessible when devices are in communication with each other. The cited section only discloses an authorization level is divided up between two or several slave cards that need to be used in a complimentary manner or

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simultaneously. This is not the disclosure that data is accessible. In fact, there is no disclosure of what is authorized when two or several slave cards are used together. Thus, the cited section does not disclose data is accessible when cards are in communication with each other.

Furthermore, "simultaneously" only describes slave cards being used at the same time. It is not the disclosure of a two data storage devices being operatively coupled together. Using two devices in a complementary manner is not the disclosure of a two data storage devices being operatively coupled together. To the contrary, applicants are positively claiming only granting access to data only when two devices are operatively coupled together and such is not disclosed by Storck et al.

The Office Action then states Storck does not disclose three party transactions and alleges Kramer discloses a three party transaction, a first interface circuit coupled to a memory device granting conditional access to a third device to data therein using an appropriate data exchange protocol between a first personal data storage device and a third device.

Initially, Applicants would like to point out that three party transactions are not claimed in claim 8. Furthermore, as discussed above, neither Storck nor Kramer disclose or suggest granting access to data only when a second data storage device is operatively coupled to a first data storage device. Such a feature is not disclosed in either reference. In fact, such a feature is not even alleged by the Office Action. Thus, the Office Action has failed to make a *prima facie* case of obviousness.

The Office Action also alleges it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Storck... to employ Kramer in order to enable optimum and secure two party and three party electronic transactions. Applicants disagree. The Office Action has not provided proper motivation to combine the references. In particular, Kramer does not provide motivation to combine its disclosed settlement of aggregated electronic transactions over a network with the method and device disclosed in Storck for effecting a transaction between a first and at least one second data carrier. There is no disclosure in the references of how the teachings of Kramer would be useful in combination with the teachings of Storck and the Office Action has not provided a proper basis for such usefulness.

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Applicants also assert that none of the cited references disclose or suggest prohibiting a transaction between the smart card and another device unless the smart card and the enabling key device are operatively coupled together, as recited in independent claim 18.

The Office Action alleges that Storck discloses at col. 12, lines 45-48 "prohibiting a transaction between the smart card and another device unless the smart card and the enabling key device are operatively coupled together." Applicants disagree and traverse the Office Action's mischaracterization of the Storck reference. Col. 12, lines 45-48 expressly disclose, "It is also possible to divide up an authorization level between two or several slave cards which will then need to be used in a complimentary manner or simultaneously." This is not the disclosure of prohibiting a transaction between a smart card and another device unless the smart card and the enabling key device are operatively coupled together. In fact, there is no disclosure of what the divided authorization is used for. Furthermore, this is not the disclosure of operatively coupling cards together. In an earlier section, the Office Action alleges complementary means two cards must operate together to complete authorization. However, this does not result in the two cards being operatively coupled together. For example, the cards may be separately coupled to another device in a complementary manner.

Thus, the cited section does not disclose prohibiting a transaction between the smart card and another device unless the smart card and the enabling key device are operatively coupled together, as recited in independent claim 18.

Furthermore, Storck et al. expressly discloses that a user can carry out any data processing operation in combination with one or several microcircuit cards (col. 13, lines 40-43). This is the exact opposite of the claimed granting access to data only when a second device is operatively coupled to the first device or prohibiting a transaction between a smart card and another device unless the smart card and an enabling key device are operatively coupled together. In particular, this expressly illustrates that access is granted to the device in Fig. 4 to data in a first device, such as one microcircuit card, without the presence of a second device, a second microcircuit card. This illustrates how Storck et al. clearly does not disclose granting access to data in a memory of a first device only when a second personal data storage device is operatively coupled to the first device.

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Therefore, Applicants respectfully submit that independent claims 1, 8, 14, and 18 and define patentable subject matter. The remaining claims are either not rejected or depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct any fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



Matthew C. Loppnow
Attorney for Applicant
Registration No. 45,314

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Phone No. (847) 523-2585
Fax No. (847) 523-2350

Please send correspondence to:
Motorola, Inc.
Intellectual Property
600 North U.S. Highway 45
Libertyville, IL 60048